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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,408	11/08/2001	Nobutaka Wakamiya	19036/34546A	6355
4743	7590	05/11/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,408

Applicant(s)

WAKAMIYA, NOBUTAKA

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Formal Matters

- A. The Amendment dated 2/20/04 has been entered into the record.
- B. Claim 10 is pending and is the subject of this Office Action.
- C. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Specification

- A. The specification remains objected to since Applicants' reference to US 09/011,375 is incorrect. The correct application number is US 09/011,735. Appropriate correction is required.
- B. The objection to the title has been withdrawn in view of Applicants' amendment.

3. Claim Rejections - 35 USC § 112, first paragraph – scope of enablement

- A. All rejections under 35 USC 112, first paragraph, enablement, have been withdrawn in view of Applicants' amendment to the claims to limit claim 10 to a hMBP with anti-influenza A activity.

4. Claim Rejections - 35 USC § 112, first paragraph – written description

- A. All rejections under 35 USC 112, first paragraph, written description, have been withdrawn in view of Applicants' amendment to the claims to limit claim 10 to a hMBP with anti-influenza A activity.

5. Claim Rejections - 35 USC § 112, first paragraph – new matter

- A. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites "isolated". Applicants are required to point out exactly where in the specification the term "isolated" is supported. This also raises the issue as how "purified and isolated" differs from the previous limitation of "purified." **This is a new matter rejection.**

Art Unit: 1647

6. Claim Rejections - 35 USC § 112, second paragraph

A. Claim 10 remains rejected under 35 USC 112, second paragraph, for the reasons already of record on page 4 of the Office Action dated 9/17/03. Applicants argue that Malhotra et al. teach the various domains of MBP claimed in the present invention. The Examiner requests the submission of the Malhorta paper. Furthermore, the phrase "N terminal region carrying cysteine" is also unclear.

B. The rejection of claim 10 under 35 USC 112, second paragraph, has been withdrawn in view of Applicants' amendment to replace the term "calcium dependent lectin" with "hMBP."

7. Claim Rejections - 35 USC § 102

A. The rejections of claim 10 under 35 USC 102 as being anticipated by either Wakamiya et al. or Hartley et al. have been withdrawn in view of Applicants' limitation of claim 10 to "hMBP."

B. Claim 10 is rejected under 35 USC 102(b) as being anticipated by Kawasaki et al. (J. Biochem). The claim recites a purified and isolated hMBP. Kawasaki teach an isolated hMBH (Abstract). The hMBH of both Kawasaki et al. and the present invention are the same regardless of the claimed method steps of the present invention. The present claim is a product-by-process claim. The protein of Kawasaki would inherently possess the characteristics of the claimed invention. (Ex parte Novitski, 26 USPQ 1391). Though not being cited as a reference relied upon in the rejection, Malhotra et al. (reference C12 on the Form 1449 dated 9/17/03) do teach that MBP and conglutinin have been shown to bind to influenza viruses and to inhibit the infectivity and haemagglutinating activity of influenza viruses.

8. Conclusion

A. No claim is allowable.

Art Unit: 1647

Advisory information

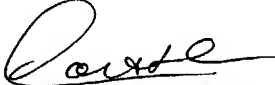
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (571) 272-0887.

Official papers filed by fax should be directed to (703) 872-9306. Fax draft or informal communications with the examiner should be directed to (571) 273-0888.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0700.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
May 07, 2004


ROBERT LANDSMAN
PATENT EXAMINER